

## REMARKS

Claims 1-8 were examined and reported in the Office Action. Claims 1-8 are rejected. Claims 6-8 are canceled. Claim 1 is amended. Claims 1-5 remain.

Applicant requests reconsideration of the application in view of the following remarks.

### I. 35 U.S.C. § 102(e)

It is asserted in the Office Action that claims 1, 6 are rejected under 35 U.S.C. § 102(e), as being anticipated by U. S. Patent No. 6,798,764 issued to Jiang ("Jiang"). Applicant has canceled claim 6. Applicant respectfully traverses the aforementioned rejection regarding claim 1 for the following reasons.

According to MPEP §2131,

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant's claim 1 contains the limitations of

[a] method for recognizing a request for data transmission by a mobile/base station RRC(Radio Resource Control) using a network transfer device, by which the mobile/base station RRC can recognize the request for data transmission using the network transfer device in a state where recognition of the request for data transmission is disabled, the method comprising: (a) the mobile/base station RRC setting the network transfer device in a suspend state to recognize a request for data transmission from an up/down link; (b) the

network transfer device in the suspend state recognizing the request for data transmission to the up/down link, and sending a message to the mobile/base station RRC to inform the mobile/base station RRC that it recognizes the request for data transmission; (c) the mobile/base station RRC recognizing the request for data transmission according to a received message from the network transfer device and transiting to an active state; and (d) the network transfer device transiting to the active state using the mobile/base station RRC.

In other words, a mobile/base station RRC sets up the network transfer device (RLC, PDCP) in a suspend state, that is, a state by which the request for data transmission is recognizable. This is done in order to easily transit to an active state in the case of recognizing the request for traffic after temporarily interrupting the request for traffic transmission using a wireless Internet service. After that, the network transfer device recognizes the request for data transmission and then reports to the RRC, and thus the RRC and the network transfer device transit to an active state.

Jiang discloses that the layer 3 interface manages the finite state machine to change the ciphering configuration of the channel, and manages the finite state machine to a null state or a reset pending state after changing the ciphering configuration of channel. Distinguishable, the layer 3 interface manages the finite state machine to a suspend state when changing the ciphering configuration of the channel in Jiang. Jiang, however, does not disclose, teach or suggest that the finite state machine recognizes a request for data transmission and reports the request to the layer 3 interface(RRC) in a suspend state. That is, Jiang does not teach, disclose or suggest

recognize a request for data transmission from an up/down link; (b) the network transfer device in the suspend state recognizing the request for data transmission to the up/down link, and sending a message to the mobile/base station RRC to inform the mobile/base station RRC that it recognizes the request for data transmission; (c) the mobile/base station RRC recognizing the request for data transmission according to a received message from the network transfer device and transiting to an active state; and (d) the network transfer device transiting to the active state using the mobile/base station RRC.

Therefore, since Jiang does not disclose, teach or suggest all of Applicant's amended claim 1 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(e) has not been adequately set forth relative to Jiang. Thus, Applicant's amended claim 1 is not anticipated by Jiang.

Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejections for claims 1 and 6 are respectfully requested.

## II. 35 U.S.C. § 103(a)

A. It is asserted in the Office Action that claims 2-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang as applied to claim 1 above, and further in view of U.S. Application No. 2001/0055298 applied for by Baker et al ("Baker"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." "All words in a claim must be considered in judging the patentability of that claim against the prior art." (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claims 7-8 are canceled. Applicant's claims 2-5 directly depend on amended claim 1. Applicant has addressed Jiang above in section I regarding amended claim 1. As asserted above, Jiang does not disclose, teach or suggest that the finite state

machine recognizes a request for data transmission and reports the request to the layer 3 interface(RRC) in a suspend state. That is, Jiang does not teach, disclose or suggest

recognize a request for data transmission from an up/down link; (b) the network transfer device in the suspend state recognizing the request for data transmission to the up/down link, and sending a message to the mobile/base station RRC to inform the mobile/base station RRC that it recognizes the request for data transmission; (c) the mobile/base station RRC recognizing the request for data transmission according to a received message from the network transfer device and transiting to an active state; and (d) the network transfer device transiting to the active state using the mobile/base station RRC.

Baker discloses that a RLC and PDCP are used to transfer wireless data. The general concept of Baker is different from Applicant's claimed invention. Moreover, Baker does not teach, disclose or suggest

recognize a request for data transmission from an up/down link; (b) the network transfer device in the suspend state recognizing the request for data transmission to the up/down link, and sending a message to the mobile/base station RRC to inform the mobile/base station RRC that it recognizes the request for data transmission; (c) the mobile/base station RRC recognizing the request for data transmission according to a received message from the network transfer device and transiting to an active state; and (d) the network transfer device transiting to the active state using the mobile/base station RRC.

Therefore, even if Jiang were combined with Baker, the resulting invention would still not include all of Applicant's claimed limitations. And, therefore, there would be no motivation to combine Jiang with Baker. Moreover, by viewing the disclosures of Jiang and baker, one can not jump to the conclusion of obviousness without impermissible hindsight. According to MPEP 2142,

[t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention

'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences,' conduct the search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicant submits that without first reviewing Applicant's disclosure, no thought, whatsoever, would have been made to

recognize a request for data transmission from an up/down link; (b) the network transfer device in the suspend state recognizing the request for data transmission to the up/down link, and sending a message to the mobile/base station RRC to inform the mobile/base station RRC that it recognizes the request for data transmission; (c) the mobile/base station RRC recognizing the request for data transmission according to a received message from the network transfer device and transiting to an active state; and (d) the network transfer device transiting to the active state using the mobile/base station RRC.

Neither Jiang, Baker, and therefore, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's amended claim 1, as listed above. Since neither Jiang, baker, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claim 1, Applicant's amended claim 1 is not obvious over Jiang in view of Baker since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly depend on amended claim 1, namely claims 2-5, would also not be obvious over Jiang in view of Baker for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 2-5, 7 and 8 are respectfully requested.

**CONCLUSION**

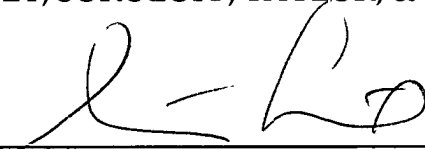
In view of the foregoing, it is submitted that claims 1-5 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

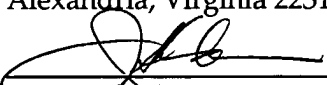
Dated: December 30, 2005

By:   
Steven Laut, Reg. No. 47,736

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California 90025  
(310) 207-3800

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on December 30, 2005.

  
Jean Svoboda